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PATENT
Customer No. 22,852
Attorney Docket No. 07414.0011-01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Ward K. FRYE et al.) Group Art Unit: 1743
)
Application No.: 09/848,270) Examiner: L. Alexander
)
Filed: May 4, 2001)
)
For: SYSTEM AND METHOD FOR)
FILLING A SUBSTRATE WITH A)
LIQUID SAMPLE)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY TO OFFICE ACTION

In reply to the Office Action dated August 14, 2003, Applicants respectfully request that the Examiner reconsider the present application and withdraw the claim rejections set forth in the above-identified Office Action for the reasons explained below.

Double Patenting Rejection

In the Office Action, claims 39-49 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-29 of U.S. Patent No. 5,653,581 ("the '581 patent"). As discussed below, Applicants respectfully submit that this rejection should be withdrawn.

A rejection under the doctrine of obviousness-type double patenting is appropriate only when a claim in an application is not patentably distinct (i.e., merely an

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obvious variation) from the subject matter claimed in a commonly owned patent.

M.P.E.P. 804.

In this case, the double patenting rejection is improper because each of claims 39-49 defines subject matter that is patentably distinct from the invention defined in claims 1-29 of the '581 patent. For example, while claims 1-29 of the '581 patent define "a scanning system for detecting fluorescence emitted from a plurality of samples in a sample tray" and "a detection system for detecting fluorescence from a plurality of sample holders in a sample tray," claims 39-49 of the present application define "an apparatus for positioning a substrate with a plurality of sample detection chambers in a detection unit" and "a method of positioning a substrate with at least one sample detection chamber into a sample detection instrument." As is apparent, an apparatus or method for positioning a substrate, as defined in claims 39-49, is patentably distinct from a scanning system or detection system, as defined in claims 1-29 of the '581 patent.

Furthermore, since a double patenting rejection of the obviousness-type is analogous to the nonobviousness requirement of 35 U.S.C. § 103, any analysis employed in an obviousness-type double patenting rejection must parallel the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. Thus, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103, must be employed when making the obvious-type double patenting analysis.

M.P.E.P. § 804. The Office Action, however, lacks such factual inquiries required for the obviousness-type double patenting analysis.

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For at least these reasons, the rejection of claims 39-49 under the doctrine of obviousness-type double patenting is improper. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

Rejection Under 35 U.S.C. § 102(e)

In the Office Action, claims 39-40 and 44-49 were rejected under 35 U.S.C. § 102(e) as being anticipated by Woudenberg et al. (U.S. Patent No. 6,015,674), Woudenberg et al. (U.S. Patent No. 5,928,907), or Porrazzo et al. (U.S. Patent No. 5,837,197). Applicants respectfully traverse this rejection.

Independent Claim 39 and Its Dependent Claims

Independent claim 39 recites an apparatus comprising, among other things, "a frame assembly ... configured so that a substrate may be positioned in the frame assembly," "a lens assembly ... including a plurality of plates, one of said plates comprising a lens plate in which at least one lens is located for focusing a light which passes through the lens."

A claim is anticipated under 35 U.S.C. § 102 only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. As detailed below, none of the cited references anticipates the claimed invention because each of the cited references fails to disclose each and every element of the claimed invention.

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Woudenberg et al.¹ does not disclose, among other things, “a frame assembly ... configured so that a substrate may be positioned in the frame assembly,” as recited in independent claim 39. Nevertheless, the Examiner appears to have alleged that a heat conducting element 20 of Woudenberg et al. corresponds to the recited “frame assembly.” Applicants respectfully disagree with this allegation.

The heat conducting element 20 of Woudenberg et al. is not a “frame assembly.” Moreover, the recited “frame assembly” is a structural element of an apparatus for positioning a substrate in a detection unit. That is, the recited “frame assembly” is configured to position a substrate in the frame assembly, so that the substrate can be positioned in a detection unit. The heat conducting element 20 or any other element of Woudenberg et al., however, fails to disclose such a structural configuration.

For at least these reasons, Woudenberg et al. cannot anticipate independent claim 39 and its dependent claims.

With respect to Porrazzo et al., the Examiner appears to have relied on Figure 7a which discloses an alternative lens system. Porrazzo et al., however, does not disclose “a plurality of plates, one of said plates comprising a lens plate in which at least one lens is located for focusing a light which passes through the lens.” Instead, Porrazzo et al. merely discloses a viewing tube 27 that includes a lens holder 22 for an objective lens 23 and a focusing lens 21. There is no disclosure for the recited “plurality of plates.” Therefore, Porrazzo et al. also cannot anticipate independent claim 39 and its dependent claims.

¹ Since Woudenberg et al. (U.S. Patent No. 6,015,674) is a continuation of Woudenberg et al. (U.S. Patent No. 5,928,907) and thereby discloses substantially identical subject matter, these two references are combined for discussion purposes.

For at least these reasons, reconsideration and withdrawal of the rejection applied to independent claims 39 and its dependent claims 40-47 is respectfully requested.

Moreover, the claim rejection fails to specifically point out how the subject matter defined in each of dependent claims 40-47 is allegedly disclosed or suggested by the cited references, such that it is unclear as to which element of Woudenberg et al. or Porrazzo et al. allegedly corresponds to each of the recited elements of claims 40-47. For example, it is unclear which elements the Examiner alleges correspond to:

- “a top plate with at least one hole corresponding to each lens of the lens plate” of claim 40;
- “a middle plate ... providing support for each lens of the lens plate [and] being pressed against a bottom surface of the top plate and the lens plate” of claim 41;
- “a plurality of flexible biasing members for providing support for each lens of the lens plate by biasing each lens toward the lens plate” of claim 42;
- “a sealing element on the bottom surface thereof for engaging said substrate,” of claim 44; and
- “a support plate with an upper surface against which the substrate may be placed and at least one raised surface around a periphery of the upper surface for engaging the substrate in order to limit lateral movement of the substrate” of claim 46.

If the Examiner insists on maintaining the rejection of these dependent claims,

Applicants respectfully request that the Examiner set forth a detailed explanation of the

basis for that rejection and make any subsequent Office Action non-final to provide Applicants with a full and fair opportunity to respond.

Independent Claim 48 and Its Dependent Claim

Independent claim 48 recites “a method of positioning a substrate with at least one sample detection chamber into a sample detection instrument.” The method comprises, among other things, “placing a support frame on the sample detection instrument,” “inserting a substrate with at least one sample detection chamber in the support frame,” and “placing a lens plate over the substrate and support frame,” and “aligning at least one hole in the lens plate relative to the sample detection chamber of the substrate.”

Alleging that both Woudenberg et al. and Porrazzo et al. clearly anticipate claims 48 and 49, the Office Action fails to specifically point out how those references allegedly discloses or suggests each and every method step recited in claims 48 and 49.

None of the cited references discloses each and every method step recited in independent claim 48. For example, neither Woudenberg et al. nor Porrazzo et al. discloses, among other things, “placing a support frame on the sample detection instrument,” “inserting a substrate with at least one sample detection chamber in the support frame,” and “placing a lens plate over the substrate and support frame.” For at least these reasons, Woudenberg et al. and Porrazzo et al. fail to anticipate independent claim 48 and its dependent claim 49. Thus, reconsideration and withdrawal of this ground of rejection is respectfully requested.

Since the Office Action lacks sufficient explanation of how the claimed subject matter is allegedly disclosed or suggested by Woudenberg et al. or Porrazzo et al., if the

Examiner insists on maintaining the rejection based on those references, Applicants respectfully request that the Examiner set forth a detailed explanation of the basis for that rejection and make any subsequent Office Action non-final to provide Applicants with a full and fair opportunity to respond.

Rejection Under 35 U.S.C. § 103(a)

In the Office Action, claims 41-43 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Woudenberg et al. or Porrazo et al. Applicants respectfully traverse this rejection.

Dependent claims 41-43 depend from independent claim 39, and thus include all elements and limitations thereof. As discussed above, independent claim 39 is patentably distinguishable over the cited references. Therefore, at least by virtue of their dependency from allowable claim 39, dependent claims 41-43 should also be allowable. Reconsideration and withdrawal of this rejection is respectfully requested.

Applicants respectfully request the reconsideration of this application, withdrawal of all outstanding rejections, and the timely allowance of pending claims 39-49.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicants decline to subscribe to any statement or characterization in the Office Action, regardless of whether it is addressed above.

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Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: November 13, 2003

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